

S/N: 09/456,833



4/9/2004

DOCKET NO.: KAW-215-USAP

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 09/456,833

Confirmation No.: 6984

Applicant: Yoshikazu SAKAMOTO, et al.

Art Unit: 3713

Filed: December 7, 1999

Examiner: Hotaling, John M.

Docket No: KAW-215-USAP

Customer No: 28892

For: GAMING MACHINE

TRANSMITTAL OF REPLY BRIEF

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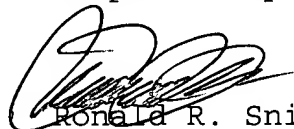
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Sir:

Transmitted herewith is Applicants' Reply Brief, in triplicate. With this filing Applicant includes a Request for Oral Hearing Before the Board of Patent Appeals and Interferences (PTO/SB/32) and a check for \$290.00 (Fee Code 1403).

The Commissioner is hereby authorized to charge any deficiency or credit any overpayment to Deposit Account 19-2816. A duplicate copy of this Transmittal is attached.

Respectfully submitted,

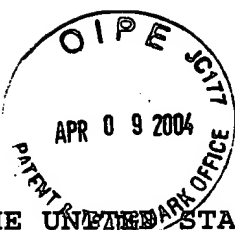
  
Ronald R. Snider  
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**REPLY BRIEF**

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Sirs:

Introduction

The Examiner's Answer repeats the position he took in finally rejecting Applicant's claims and repeats the errors made in the final rejection. The Examiner treats specific teachings of the references as abstractions in order to ignore the specific teaching. He makes statements about motivation that are factually unsupported in the record. Finally, when even the abstracted teaching of the references do not anticipate the specific claim language, he ignores the claim language.

The Examiner Ignores the  
Teachings of the References as a Whole

The Examiner ignores the teachings of the references as a whole, and instead selects bits and pieces of each of the references, extracts from these bits and pieces and abstract teaching unrelated to the references as a whole, and finally puts

together these extracted, abstract teaching to reconstruct Applicant's invention. It is clearly improper to ignore the teachings of the references as a whole. The Slomiany reference, read as a whole, discloses a specific bonus game referred to in the specification as the BIG BANG PIGGY BANK game, which is explained in Applicant's Appeal Brief. There is no reason for one of ordinary skill in the art to substitute a bonus game involving a progressive story for the game disclosed in Slomiany. This would change the nature of the Slomiany game

???There Are No Facts of Showing Motivation  
Record to Combine the References

The factual question of Motivation is material to patentability and cannot be resolved on subjected belief and on unknown authority, see In Re: Sang Su Lee, 61 USPQ 2nd 1430 (Fed. Cir. 2002). The Examiner's position, as stated on page 8 of the Examiner's answer is:

"One would be motivated to combine these references in order to provide improved communication and information to the user of a game machine as disclosed above and since the references disclose that the information can be displayed in multiple places, such as the main display, auxiliary display, or both, or a combination of displays."

There is no factual basis to assert that one skilled in the art would believe that substituting the progressive story of the Okada or Claypole references in Slomiany would "provide improved communication and information to the user of a game machine".

The Examiner Ignores Specific Claim Language

The Examiner has apparently abandoned his original contention that the claim 1 limitation of two progressive stories related, but distinguishable from one another "may be akin to a new chapter in the story relevant to a game outcome". Now, in its place, the Examiner, on the top of page 10 of the Examiner's answer, makes a statement that "the different pictures with different aspects of the cowboy on the horse are different parts of a story related to one another". This may be a true statement, but it is not relevant to the language of claim 1. Namely, the claim calls for a progressive story for the first special game mode, and a new progressive story for the second special game mode with the new progressive story related to, but distinguishable by a player from the first mode of progressive story. Simply stated, parts of a single story are not the same, or even analogous to, a story for the first special game mode and a new story for the second special game mode. The Examiner is unable to contort the references by abstraction to get two stories, as called for in Claim 1, so he ignores the limitation.

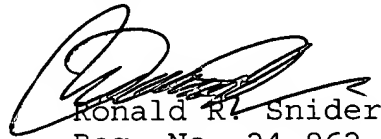
Similarly, claim 35 specifically points out that aspect of Applicant's invention in which an image display section "simultaneously shows individual outcomes of past plays" in said first special game mode and individual outcomes of past plays in said second special game mode.

The Slomiany reference discloses a bonus game BIG BANG PIGGY BANK shown best in Figures 5 and 6 of Slomiany. Slomiany does not explicitly disclose that there is a more than one mode of operation

in this bonus game. In any event, it is clear that Slomiany does not simultaneously display individual outcomes of past plays in a first special game mode and individual outcomes of past plays in a second special mode. Slomiany shows in Figures 5 and 6 at reference numeral (3) a total score for all plays in a bonus game. The "credit meter" referred to at the end of page 13 of the Examiner's answer is presumably the BONUS 36 of Figures 5 and 6. This too displays accumulative value. Thus in Slomiany the display does not distinguish between a first and second special game mode, and does not show individual outcomes of past plays.

For the reasons stated above, Applicant respectfully requests that the Examiner be reversed as to all claims.

Respectfully submitted,

  
Ronald R. Snider  
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